

## **REMARKS / ARGUMENTS**

### ***Remaining Claims***

Sixteen (16) claims (Claims 1, 3 – 10, and 12 – 18) remain pending in this application. Applicants have amended claim 1.

### ***Rejection of Claims 1, 3, 6, 16 and 17 under 35 USC §103(a) – Martin and Ono***

Claims 1, 3, 6, 16 and 17 were rejected by the Examiner as being unpatentable over Martin in combination with Ono.

Regarding claims 1 and 16, the Examiner relies on Ono for disclosure of a “UV ray lamp 8 including a light emitting part surrounded by optical fibers.” Claim 1 has been amended to include high UV illumination and rapid crosslinking. The process described in Martin is a two-step illumination process. The focus of such a process, therefore, is not rapid crosslinking but rather, as the Martin specification discloses an “apparatus and method for partially curing...” Ono does not cure this deficiency as it is not used for polymerization but rather, is used to cure adhesive resins. Applicants have included a translation of the entire Ono reference. If the Examiner requires a certified translation, please contact the undersigned.

Primarily, Ono is directed to curing resins, specifically adhesive resins. Moreover, Ono is used to “spot-irradiate an adhesive resin.” The Examiner states that it would have been obvious to one of skill in the art to modify the optic-based UV light system of Martin by providing optical fibers surrounded by the lamp as taught by Ono. The Examiner erroneously relied upon a figure and an Abstract without translating a Japanese specification, which upon closer read, clearly does not suggest using its process outside the field of adhesive resins for spot irradiation.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Although the Examiner references *In re McLaughlin* and *In re Fine*, *In re Jones* and *In re Keller*, **more recent** court cases and importantly, the MPEP, state that the Examiner is required to show a motivation to combine these references. In *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) the court concluded that the Board

"reversibly erred in determining that one of [ordinary]skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention[to have been] obvious." *Id.* at 1357, 47 USPQ2d at 1457. The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." *Id.*

The modification suggested by the Examiner uses hindsight, which is improper. The Examiner is required to show a motivation to combine. For this reason, Applicants respectfully request that the rejections made to claim 1 be reconsidered and withdrawn.

Claims 3, 6, and 17 all depend from claim 1 and as such the same arguments apply. With specific regard to claim 6, it would not have been obvious to combine Martin and Ono. The requisite motivation to combine these references must come from the prior art, not the Applicant's specification. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ.2d 1529,1531-1532 (Fed. Cir. 1998). Martin nor Ono provide a motivation for their combination.

The Examiner rejected claim 4 as being unpatentable over Martin in view of Ono and further in view of Biller. Biller does not remedy the deficiencies of Martin and Ono because. Because claim 4 depends from claim 1, which should now be found allowable, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

The same arguments apply to claims 5, 7, 8, and 12-14. These claims depend from claim 1 and as such the combination of Martin and Ono cannot render the present invention obvious. The Examiner has also cited the Nath reference, stating that Nath "discloses a flexible liquid light guide." Nath discloses a light guide designed for use within the human body. There is clearly no teaching in Nath to use its light guide to cure ophthalmic material. Nor is there a teaching in any other reference to combine it with Nath. Such a teaching or motivation to combine is absolutely required and it cannot be found using the present references. Only hindsight could combine a flexible light guide with a method for spot illuminating an adhesive resin to achieve the present invention.

Regarding claims 9 and 10, the combination of Martin, Ono, and Gonser (the '344 reference) would not have been obvious to one of skill in the art, nor is there a teaching or suggestion to combine these references. For the reasons stated above,

none of the references in combination would have been obvious, but for use of hindsight, which is not permissible.

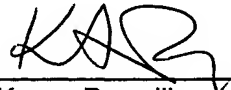
Regarding claim 15, there is no teaching or suggestion to combine this reference with Ono or Martin. Primarily, the Sopori reference is related to a solar stimulator that is designed to produce the entire solar spectrum for testing purposes and provides no basis for a modification with the other references to create the present invention. Applicants respectfully request that this rejection be reconsidered and withdrawn.

### **CONCLUSION**

In view of the foregoing and in conclusion, Applicants submit that the 35 USC § 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not anticipated by or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'KAR', is written over a horizontal line.

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Date: 12 April 2006  
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